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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,293	01/02/2002	Arnold B. Finestone	82017-1399	1249

28765 7590 12/16/2003

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,293

Applicant(s)

FINESTONE ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in the specification in the amendment filed October 1, 2003 (Paper 8) have been received and considered by Examiner.
2. The amendment made in claim 12 in Paper 8 has been received and considered by Examiner.
3. The markings in the claims shown in Paper 8 (other than in claim 12) indicate amendments that were made prior to the filing of Paper 8. Claim 19 is incorrectly labeled as “(currently amended)” in Paper 8; claim 19 was amended as marked in Paper 8 in the previous amendment filed April 29, 2003 (Paper 5).

NEW REJECTIONS

Claim Rejections - 35 USC § 112

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last three lines of claim 12 are drawn to “a dilatable container product” that has “enhanced tear and burst strength compared to dilatable containers made f[ro]m plastic coated cellulosic papers”. Applicant’s invention as claimed reads on the recitation “dilatable containers made f[ro]m plastic coated cellulosic papers”. The laminate sheeting as claimed is structurally equivalent to a “plastic coated cellulosic paper”. The term “coated” is a method limitation that has not been given patentable weight since the method of forming the laminate sheeting is not germane to the issue of patentability of the laminate sheeting itself. The structure recited by the phrase “plastic coated cellulosic paper” is that of a cellulosic paper that has at least

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one layer of plastic on at least one of the sides of the paper. The paper as claimed does not exclude "cellulosic paper" from the scope of the type of paper recited by the term "paper". Given the above, Applicant is comparing Applicant's invention to itself in claim 12; Applicant is claiming that Applicant's invention has "enhanced tear and burst strength" compared to, presumably, the tear and burst strength of, inter alia, Applicant's invention. The condition where Applicant's invention has "enhanced tear and burst strength" compared to the tear and burst strength of Applicant's invention is not possible; therefore, Applicant has failed to distinctly claim the subject matter which applicant regards as the invention.

REPEATED REJECTIONS

5. The 35 U.S.C. 112 rejection of claim 12 made of record in paragraph 13 of Paper 6 has been repeated because while Applicant attempts to answer the question raised by the Final Office Action (Paper 6), "enhanced" as compared to what?, via the amendment made in claim 12 in Paper 8, exactly to what the "enhanced tear and burst strength" is being compared is unclear. The properties of one container cannot be compared to another container; the properties of one container would be compared to those same properties of another container. Insertion of --the tear and burst strength of-- between "to" and "dilatable" in the second-to-last line of the claim would overcome this rejection.

6. The 35 U.S.C. 103(a) rejection of claims 12-20 over Redmond in view of Finestone et al. that was repeated in paragraph 12 of Paper 6 has been repeated for the reasons previously made of record in paragraph 12 of Paper 6. Since the limitation that was added in claim 12 in Paper 8 recites an impossible condition as discussed above in the new 35 U.S.C. 112 rejection, this limitation cannot be treated on its merits.

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7. The 35 U.S.C. 103(a) rejection of claims 21-25 over Redmond in view of Finestone et al. made of record in paragraph 14 of Paper 6 has been repeated for the reasons previously made of record in paragraph 14 of Paper 6.

ANSWERS TO APPLICANTS ARGUMENTS

8. Applicant's arguments in Paper 8 regarding the 35 U.S.C. 103 rejection of claims 12-20 repeated in this Office Action and of claims 21-25 repeated in this Office Action have been fully considered but are not persuasive.

Applicant argues that "certain materials may not need to be provided with a sealant", but Redmond nonetheless teaches the sealant layer, which corresponds to the reinforcing film as claimed as stated in paragraph 10 of Paper 4. Applicant argues that "In order to properly function, Redmond's sealant cannot be of high strength" and that "If the sealant were of high strength, it could not be punctured by the stiff material, so that the contents of the package could not be dispensed" and points out that the stiff material of Redmond "is not sufficiently hard or rigid" (ninth-tenth lines of page 7 of Paper 8); "sufficiently" for what purpose? Applicant states that the stiff material of Redmond, supposedly, "cannot be too strong or highly rigid or else it will be difficult to break even with the cut lines", but no evidence is provided by Applicant to show that the oriented film taught by Redmond and Finestone et al. is too "of high strength" or "too strong or highly rigid" according to the teachings of Redmond. Examiner disagrees that the claimed oriented film "cannot be used as sealants in Redmond's package" as Applicant argues; the structure taught by Redmond that enables the package of Redmond to be "an easy opening package" as Applicant characterizes the package of Redmond has nothing to do with the structure claimed in the instant application. The package taught by Redmond and Finestone et al.

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as discussed in paragraphs 12 and 14 of Paper 6 would be “easy opening” with a readily available knife or pair of scissors; the method that one uses to open the package of Redmond is irrelevant to the patentability of the package that is claimed in the instant application as is determined by the structure of the package of the claimed application. The teaching of Redmond that the package is an easy opening package is a teaching in regard to the manner in which the package is intended to be employed, and does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Furthermore, as pointed out on page 9 of Paper 6, a monoaxially stretched film, which is included in the scope of the teachings of Finestone et al. (see col. 5, lines 9-19), replaced with the sealant of Redmond would result in a package that is easy opening because the laminate would be maximally difficult to tear in one direction along the planar surface of the laminate, but easy to tear in the direction perpendicular to this maximally difficult direction along the planar surface of the laminate.

Applicant argues that “Redmond teaches away from the use of thin sheets or laminates in col. 1, lines 46-61” because “Skilled artisans would realize that such sheets are preferably made of oriented plastics for strength”, but this passage from Redmond does not remotely suggest that the reason that these “thin sheets or laminates” are difficult to open because of the type of material they are. Applicant alleges that “skilled artisans would also understand that Redmond specifically teaches against the use of plastic and foil laminates”, but Redmond explicitly teaches “the use of plastic and foil laminates” (see col. 3, lines 34-66).

Applicant alleges that “an oriented film would have sufficient strength and flexibility to conform to the shape of the bent stiff material without fracturing or breaking”, but a monoaxially

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oriented film, as discussed above, would easily break, allowing the contents of the package to be dispensed. Applicant argues that “a skilled artisan reading Redmond would be taught to use a wax or plastic coating or a weak film rather than an oriented plastic film”, but a monoaxially oriented film is a plastic coating that is maximally weak in a given direction as discussed above, used as the coating of Redmond would enable the container of Redmond to be easily opened.

Applicant argues that “the Finestone et al. laminates are made of paper-plastic or paper-plastic-paper ... [that] would not provide a moisture resistant surface”; however, Redmond teaches the structure as claimed in terms of the order of the layers and Finestone et al. is relied upon for the teachings of orientation, corona surface treatment and “cold” lamination. The Office Action does not propose substituting the various laminates taught by Finestone et al. with the sealant layer of Redmond.

The second-to-last paragraph of page 8 of Paper 8 is copied verbatim from page 7 of Paper 5. The arguments presented on page 7 of Paper 5 are addressed on page 9 of Paper 6. Applicant’s argument that “the functionality of Redmond’s invention would be impaired” is additionally addressed above.

9. The Declaration of Arnold B. Finestone, Ph.D. (Paper 10) has been received and considered by Examiner. The content of the Declaration is a rehash of Applicant’s arguments and opinions presented in Paper 8 (or vice versa), which have been addressed above in this Office Action. Furthermore, data supporting Dr. Finestone’s opinions and assertions is not presented.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

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Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,652,984 to Finestone et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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HAROLD PYON
SUPERVISORY PATENT EXAMINER
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